



Docket No.: 300.1119

In re the Application of:

Masatoshi AKAGAWA, et al.

Serial No. 10/612,222

Group Art Unit: 3726

Confirmation No. 5751

Filed: July 3, 2003

Examiner: Rick Kiltae Chang

For: COMPONENT-EMBEDDED BOARD FABRICATION METHOD AND APPARATUS FOR  
HIGH-PRECISION AND EASY FABRICATION OF COMPONENT-EMBEDDED BOARD  
WITH ELECTRONIC COMPONENTS EMBEDDED IN WIRING BOARD

**PETITION TO WITHDRAW FINALITY OF THE OUTSTANDING OFFICE ACTION**

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Attention: **MAIL STOP AF**

Sir:

The outstanding Office Action was a first action after an RCE, and was made Final. It is respectfully submitted that the finality of the Office Action is improper.

More specifically, the Applicant submitted an RCE with the previous Amendment filed March 29, 2007. In the Amendment, new claim 50 was added. New claim 50 recites features that were not cited in any of the previously pending claims. In this situation, it is respectfully submitted that it is improper for the Examiner to make the Office Action final. Moreover, it is respectfully submitted that, in this situation, it is common practice within the USPTO that the first action NOT be made final.

Further, as indicated above, new claim 50 recites features that were not recited in any of the previously pending claims. Therefore, new claim 50 clearly raises new issues "that required further consideration and/or search." See MPEP § 706.07(b). In this situation, in accordance with MPEP § 706.07(b), the outstanding Office Action should not be made final.

It should be noted that, in the outstanding Office Action, the Examiner has not addressed the recitations in claim 50. More specifically, the Examiner has not indicated where the recitations in claim 50 are shown in the references.

On page 2 of the outstanding Office Action, the Examiner indicated that the Office Action was made final because "[a]ll claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 C.F.R. § 1.114 and could have been finally rejected on grounds and art of record." The Applicant respectfully disagrees.

However, as indicated above, in the Amendment filed March 29, 2007, the Applicant added new claim 50, which recites that in said detecting, an optical reading device captures an image of the component-embedded board and detects the actual position of the first electronic component based on the image. The performance of both of these features by an optical reading device was not explicitly claimed in the previous claim set. The MPEP states that the claims of a new application may only be finally rejected in the first Office Action where:

[A]ll the claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the **grounds and art of record** in the next Office action if they had been entered in the earlier application.

MPEP § 706.07(b), emphasis added.

Neither Leedy nor Kulkarni, individually or in combination, disclose the features of claim 50. As indicated on page 4 of the Office Action, Leedy does not teach "imaging means and an optical reading device." Kulkarni discusses that "the inspection station 100 detects defects by comparing one die, on a pixel-to-pixel basis, with an adjacent die." There is no disclosure in Kulkarni of an optical reading device that both captures an image of the component-embedded board **and** detects the actual position of the first electronic component based on the image, as claimed. Further, the previous Office Action made no argument that that the art of record disclosed performing both these features in an optical reading device. Per MPEP § 706.07(b), the Examiner must demonstrate based on the previous Office Action **both** that claim 50 could have been properly finally rejected on the grounds **and** art of record.

As explicitly stated in the MPEP, both are required to make a first Office Action final, and neither does so here. As such, the Examiner **cannot** finally reject the claims on the grounds and art of record and the finality of the outstanding Office Action is improper.


**Accordingly, it is respectfully requested that a new, nonfinal Office Action be issued by the Examiner.**

If any fees are required in connection with the filing of this Petition, please charge the fees to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 7-3-2007

By:   
Michael A. Leonard II  
Registration No. 60,180

1201 New York Ave, N.W., 7th Floor  
Washington, D.C. 20005  
Telephone: (202) 434-1500  
Facsimile: (202) 434-1501